

In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 8 of 16

REMARKS

Claims 1-34 are pending. Claims 9-16 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-3, 5, 7-9, 15-19, 21-27 and 30-32 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0016822 to Bessette ("Bessette"). Claims 4 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bessette in view of U.S. Patent Application Publication No. 2004/0078215 to Dahlin et al. ("Dahlin"). Claims 10-14 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bessette in view of the reference "PDAs for Doctors: Your ticket to fast, flawless prescribing" by Chesanow ("Chesanow"). Claims 28-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bessette in view of U.S. Patent Application Publication No. 2002/0072911 to Kilgore et al. ("Kilgore"). Claims 33-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bessette in view of U.S. Patent Application Publication No. 2002/0010679 to Felsher ("Felsher").

Applicants have amended Claims 9 and 15-16, as indicated above, to overcome the rejections under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejections under §102 and §103 as set forth below.

In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 9 of 16

§112 Rejections Are Overcome

The Action states that Claims 9 and 15-16 recite limitations for which there is no antecedent basis in the claims. In particular, the Action states that the passage "the previously provided mobile terminals" in Claims 9 and 15-16 lacks or has vague antecedent basis. Applicants have amended Claims 9 and 15-16 to remove the phrase "previously provided" as indicated above. As such, the rejections under 35 U.S.C. §112, second paragraph, are overcome.

In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 10 of 16

§102 Rejections Are Overcome

A claim is anticipated under 35 U.S.C. §102 if each claimed element is found in a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986). There must be no difference between the claimed invention and the reference disclosure, as viewed by an ordinary artisan. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d at 1576.

Applicants' amended Claim 1 recites a method of presenting medical records for use by a medical provider, comprising:

extracting pre-existing medical records *in their entirety* from a database;
formatting said medical records for presentation on a mobile terminal,
comprising *providing ergonomic actuators within said medical records to move between different screens containing different information, wherein each ergonomic actuator is large enough to allow actuation via a user's finger*; and
delivering one or more of said formatted medical records to a mobile terminal possessed by a medical provider, *wherein each medical record is delivered in its entirety to a mobile terminal.*

Independent Claims 17 and 23 contain similar recitations.

Bessette fails to describe all of the recited elements of independent Claim 1. Bessette describes a network system for storage of medical records. The records are stored in a database on a server. *Each record includes* two main parts, namely a collection of data elements containing information of a medical nature for a certain individual, and *a plurality of pointers providing addresses or remote locations where medical data for that particular individual is located.* Each record also includes a data element indicative of the basic type of medical data found at the location pointed to by a particular pointer. This arrangement permits a client workstation to download the record along with the set of pointers which link the client to the remotely stored files. The identification of the basic type of information that each pointer points to allows the physician to select the ones of interest and thus *avoid downloading massive amounts of data where only part of that data is needed at that time.* (Abstract, emphasis added)

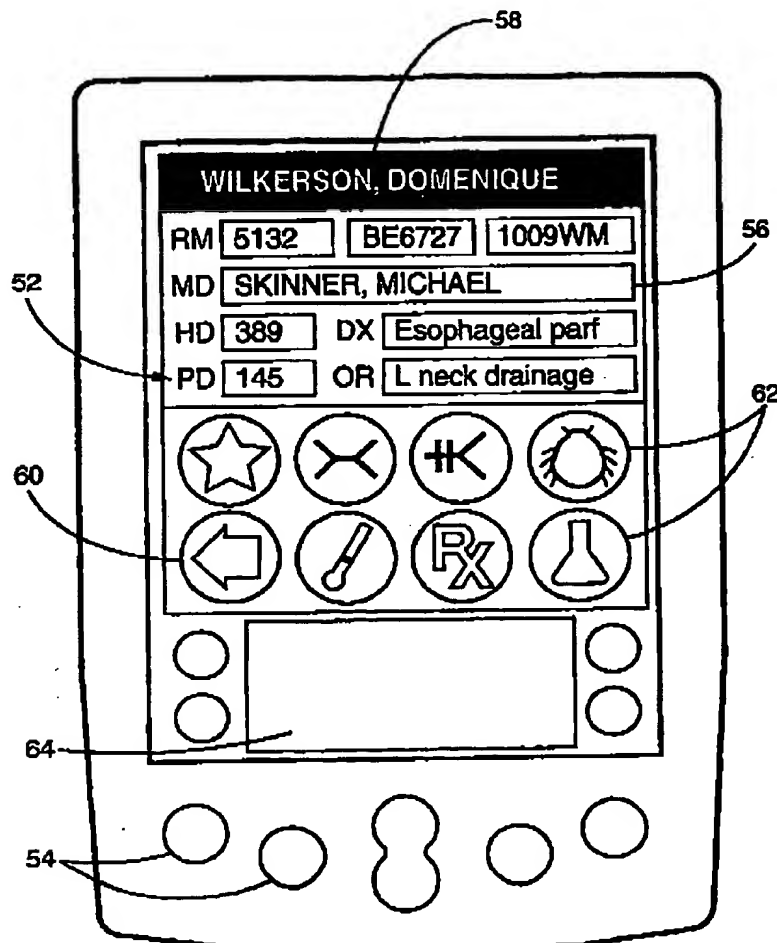
In sharp contrast, medical records for one or more patients are extracted and downloaded in their entirety to the mobile terminals of Applicants' invention. (See, for

In re: Ying *et al.*
 Serial No.: 09/776,484
 Filed: February 2, 2001
 Page 11 of 16

example, Applicants' specification on Page 27, Lines 13-18). For example, amended independent Claim 1 recites "extracting pre-existing medical records *in their entirety* from a database", and "delivering one or more of said formatted medical records to a mobile terminal possessed by a medical provider, *wherein each medical record is delivered in its entirety to a mobile terminal.*" Applicants' invention does not utilize pointers to data located elsewhere.

In addition, amended Claim 1 recites formatting the medical records that are to be downloaded in their entireties that comprises *providing ergonomic actuators within said medical records to move between different screens containing different information, wherein each ergonomic actuator is large enough to allow actuation via a user's finger.*

Fig. 2 from Applicants' application is set forth below which illustrates a plurality of ergonomic actuators 60, 62, each of which is large enough to allow actuation via a user's finger.



In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 12 of 16

Bessette does not describe ergonomic actuators that are large enough to allow actuation via a finger. To the contrary, Bessette describes a user-friendly interface provided by server 300 (Bessette, Paragraph 0099). Yet, no user-friendly interface is either described or illustrated in Bessette. As viewed by the ordinary artisan, there is *substantial* difference between Applicants' invention as claimed in independent Claim 1 and Bessette. Because Bessette does not disclose all of the recited elements of independent Claim 1, Claim 1 and all claims depending therefrom are not anticipated by Bessette. For at least the same reasons, independent Claims 17 and 23, and all claims depending therefrom, respectively, are not anticipated by Bessette.

Applicants' amended Claim 9 recites a method of presenting information to medical providers comprising:

providing each of a plurality of medical providers with a mobile terminal;
establishing a format for the information to be presented in its entirety on each of the mobile terminals;
delivering the information in its entirety to one or more of the mobile terminals.

Bessette fails to describe establishing a format for information to be presented in its entirety on a mobile terminal. In addition, Bessette fails to describe delivering information in its entirety to a mobile terminal. As described above, Bessette utilizes pointers to remote locations where medical data resides for a patient specifically to avoid downloading large amounts of data to a client workstation. Because Bessette does not disclose all of the recited elements of independent Claim 9, Claim 9 and all claims depending therefrom are not anticipated by Bessette.

Applicants' amended Claim 25 recites a method of providing medical records to a doctor treating patients within a medical facility, comprising:

providing the doctor with a mobile terminal having a memory for storing medical information regarding at least one patient;
providing a main database comprising the medical information regarding at least one patient;
sending the medical information regarding at least one patient in its entirety from the main database to the mobile terminal;
receiving updated information from the doctor at the mobile terminal; and
maintaining the main database updated by transferring said updated

In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 13 of 16

information from said mobile terminal to said main database.

Independent Claims 31 and 32 contain similar recitations.

Bessette fails to describe sending medical information from a database in its entirety to a mobile terminal. As described above, Bessette utilizes pointers to remote locations where medical data resides for a patient specifically to avoid downloading large amounts of data to a client workstation. Because Bessette does not disclose all of the recited elements of independent Claim 25, Claim 25 and all claims depending therefrom are not anticipated by Bessette. For at least the same reasons, independent Claims 17 and 23, and all claims depending therefrom, respectively, are not anticipated by Bessette.

In view of the above, the rejections under 35 U.S.C. §102 are overcome.

In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 14 of 16

§103 Rejections Are Overcome

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Court of Appeals for the Federal Circuit also has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining

In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 15 of 16

whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

For at least the same reasons set forth above with respect to 35 U.S.C. §102, Applicants respectfully assert that the primary reference, Bessette, fails to teach or suggest the recitations of Applicants' independent claims, particularly as amended above, and all claims depending therefrom. Moreover, Bessette teaches away from sending medical record information *in its entirety* to a mobile terminal. Bessette specifically downloads records to client workstations that contain pointers to remote locations where medical data resides for the stated purpose of *avoiding having to download massive amounts of data where only part of that data is needed at that time*. (Abstract, Emphasis added).

None of the secondary references cited by the Action overcome the deficiencies of Bessette. Specifically, neither Dahlin, Chesanow, Kilgore, or Felsher, alone or in combination, teach or suggest extracting pre-existing medical records in their entirety from a database, and delivering medical records in their entirety to a mobile terminal. Moreover, neither Dahlin, Chesanow, Kilgore, or Felsher, alone or in combination, teach or suggest formatting medical records for presentation on a mobile terminal that includes providing ergonomic actuators within the medical records to move between different screens containing different information, and wherein each ergonomic actuator is large enough to allow actuation via a user's finger.

Thus the primary and secondary references, alone or in combination, fail to teach or suggest all of the recitations of Applicants' independent claims. Moreover, the Action has set forth no clear and particular evidence of a suggestion, teaching or motivation to modify the primary and/or secondary references to download medical records in their entirety, and/or to format medical records that are to be downloaded in their entirety to include ergonomic actuators therewithin to allow movement between different screens

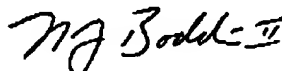
In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
Page 16 of 16

containing different information, wherein each ergonomic actuator is large enough to allow actuation via a user's finger.

Accordingly, Applicants respectfully request withdrawal of the present rejections under 35 U.S.C. §103.

In view of the above, it is respectfully submitted that this application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,



Needham J. Boddie, II
Attorney for Applicant
Registration No. 40,519

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401
Doc. No. 433066

CERTIFICATION OF FACSIMILE TRANSMISSION UNDER 37 CFR § 1.8

I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office on April 29, 2005 via facsimile number 703-872-9306.



Erin A. Campion